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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,726	08/13/2001	Denny Jaeger	4143/CIP-3	7153
7590	01/06/2004		EXAMINER	
Harris Zimmerman Law Offices of Harris Zimmerman Suite 710 1330 Broadway Oakland, CA 94612-2506			EISEN, ALEXANDER	
			ART UNIT	PAPER NUMBER
			2674	6
DATE MAILED: 01/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/928,726	JAEGER, DENNY
	Examiner	Art Unit
	Alexander Eisen	2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 December 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 and 22-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 1-11 and 22-29 is/are allowed.

6) Claim(s) 12 is/are rejected.

7) Claim(s) 13-16 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . 6) Other: ____ .

DETAILED ACTION

1. In response to the previous Office action the applicant has amended claims 12 and 17.

This amendment has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao, US 6,515,654 B1.

With respect to **claim 12** Liao discloses a touch screen system (FIG. 1) having at least one physical control device (sensing pen 20) operating on a touch screen (13) comprising a first antenna (333) secured adjacent to the touch screen (all electrical components are located on the control circuit board 30, which is adjacent to the touch screen 13), and control circuit means (transmitting circuit 33; FIGS. 3A-C) for driving said antenna to generate EM field extending across the touch screen; the physical control device (pen 20) including resonant antenna means (FIG. 4) for receiving said EM field and re-radiating an electromagnetic response signal (column 3, lines 7-15); means for selectively operating said resonant antenna (switches 220, 230) when said physical control device is touched by a user (column 3, lines 36-38), and for selectively disabling said resonant antenna means when said physical control device is not touché by a user; said control circuit further including means for receiving said response (receiving circuit 34)

signal and entering a control command into an electronic device operatively associated with said touch screen system (column 3, lines 24-30).

Even though Liao does not explicitly call the pen a post assembly, the pen is definitely an assembly, and when installed into what seemingly represents a penholder (seen at the upper side of Lin's touch screen) would become a post. When the pen is installed into the penholder then it still can emit commands by pressing the button 220, and therefore can be adapted to be operated in stationary fashion, as claim 12 requires.

Also, it would have been obvious to one of ordinary skill in the art at the time when the invention was made that the pen of Liao can be operated in stationary fashion, as required by newly added limitation, when a user operates the button 220 while holding the pen in fixed position over certain coordinates representing an icon or a virtual button, as it would be known to those of ordinary skilled in the art as a graphical user interface, because that operation can be carried out when the pen is in the fixed position (see Liao; col. 3, lines 30-38).

Allowable Subject Matter

4. **Claims 1-11, 17 and 22-29** are allowed.
5. The reason for allowance of **claims 1-11 and 22-29** has been conveyed to the applicant in the previous Office action.
6. As to **claim 17**, the reason for allowance is clear from the record in view of applicant's amendment and arguments.
7. Claims **13-16** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with regards to claim 12 filed 15 December 2003 have been fully considered but they are moot in view of new grounds of rejection. Applicant argues that the pen of Liao cannot be broadly interpreted as a post, that this interpretation is "without merit either logically or factually"[sic]. Applicant further asserts that a post is a fixed structural member, whereas a pen is an instrument for writing, "try writing your name with a post"[sic]. While some of the above statements are correct, examiner respectfully disagrees that the pen cannot be a post - it can be "posted" into a penholder, for instance, whereby the pen will be in fixed vertical position and definitely look like a post. On the other hand, a post assembly is not necessarily a fixed post, because before it is fixed and immobilized, it has to be assembled, carried to and adhered to the fixed position. The example of such a post is the applicant's post assembly itself; it has to be adhered to the touch screen (releasably by the way), but before this is done, one can write his name with a post, since it is still movable. Just as the post of applicant's invention can be releasably attached to the screen, so the pen of Liao can be removably inserted into a pen holder and then be in the fixed position.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is **(703) 306-2988**. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on **(703) 305-4709**.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is **(703) 306-0377.**



Alexander Eisen
December 31, 2003